

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

BURROUGHS

Serial No.: 10/561,801

Filed: July 14, 2006

For: METHOD AND APPARATUS FOR
PERFORMING POSITION
DETERMINATION WITH A SHORT
CIRCUIT CALL FLOW

Group Art Unit: 2614

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Creighton H. Smith
Examiner

Dear Sir:

The following comments are in response to the Reasons for Allowance dated May 2, 2008.

The comments begin at page 2.

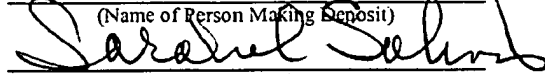
I hereby certify that this correspondence is being sent
via electronically addressed to the Commissioner for
Patents, P.O. Box 1450, Alexandria, VA 22313-
1450, on:

August 01, 2008

(Date of Deposit)

SaraNel Salinas

(Name of Person Making Deposit)



(Signature)

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

This is in response to Reasons for Allowance included in the Notice of Allowance mailed May 2, 2008.

Applicant thanks the Examiner for indicating allowance of claims 1-41 placing the application in condition for grant.

Applicant respectfully contends that the claimed "acknowledgement" step would not be inherent upon a mobile terminal receiving a network query for the location/position of the mobile terminal and sending its location/position to the network.

In order for a function to be inherent, the function must necessarily be performed by the process and cannot merely be a probability or a function that *may* be performed. The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

The function of a mobile terminal sending its location/position to a network in response to a network query for such information is not inherent because there are alternatives to how the network may receive the information. One alternative is the example described by the Examiner, where the mobile terminal sends its location/position in response to the query. A second alternative is where the mobile terminal initiates a mobile-assisted position location, where a network-based device, such as Position Determination Entity (PDE) determines the location/position of the mobile terminal and reports it in response to the query. This network based alternative is described in Applicant's Specification, at paragraph [0006] of U.S. Patent Application Publication No 2006/0276167.

Thus, because there is an alternative to the mobile terminal sending its location, the act of the mobile terminal sending its location in response to a network query cannot be inherent.

The Examiner's statement that "No obvious combination of references found would have taught one of ordinary skill in the art to make and use applicant's method and apparatus as claimed" is understood to refer at least to those reference identified in the Examiner's PTO-892 form, as well as those references identified in the PCT ISR submitted upon entry into the U.S. National phase. The PCT ISR, listing US 6,353,743 to Karmel, US 6,369,751 to Naruse, and US 6,453,237 to Fuchs et al., was expressly noted as having been received in the

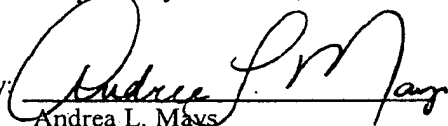
PTO in the PTO Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 C.F.R. 1.495 dated 08/28/2006.

CONCLUSION

If there are any other fees due in connection with the filing of these comments, please charge the fees to our Deposit Account No. 17-0026. If a fee is required for an extension of time under 37 CFR 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: August 01, 2008

Respectfully submitted,

By: 
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